

REMARKS

Amendments to the Claims

Applicant respectfully submits that the amendments to Claims 11, 23, 34, 46, 57, and 69 find support in the application as originally filed.

Support for the added subject matter is found in the application as originally filed. Specifically, support for the hand railing and the stretchable layer being releasably adhered to the outer surface of the hand railing is found in FIGS. 9-10 and in the Specification on Page 14, lines 10-11, where it states, “4-way stretchable material layer 304 is releasably adhered to railing 302.”

Support for the skin layer being axially wrapped around the outer surface of the hand railing is found in FIGS. 9-11.

Support for the edges of the skin layer not overlapping is found in the Specification on Page 9, lines 10-13, where it states, “In another embodiment, the edges are tapered but wrapped in such a way that they do not overlap to provide still more friction for the user. In still another embodiment, the lengthwise edges of skin layer 104 and 4-way stretchable layer 112 are not tapered for instances when the edges do not overlap.”

Therefore, Applicant respectfully submits that no new matter has been introduced by the amendments to the claims and that Claims 11, 23, 34, 46, 57, and 69 are currently in condition for allowance.

Claim Rejections – 35 U.S.C. §103(a)

Claims 11, 34 and 57 stand rejected under 35 U.S.C. §103(a), as being unpatentable over Shomo (U.S. Patent No. 4,660,832).

For a §103 obviousness rejection to be proper, the Examiner must meet the burden of establishing that all elements of the invention are disclosed in the prior art; that the prior art relied upon, coupled with knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or combined references; and that the proposed modification of the prior art must have had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In Re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); *Amgen v. Chugai Pharmaceuticals Co.*, 927 U.S.P.Q.2d 1016, 1023 (Fed. Cir. 1996).

Amended Claim 11 recites a system for providing a grip on hand railing comprising “a hand railing having an outer surface; a skin layer axially wrapped around said outer surface of said hand railing such that the edges of said skin layer do not overlap ... a 4-way stretchable material layer ... wherein said 4-way stretchable layer is releasably adhered to said outer surface of said hand railing.”

Shomo fails to disclose a railing and a stretchable layer releasably adhered to the outer surface of a hand railing, as recited in Claim 11. Shomo is only directed towards a handle for use on products such as “tennis rackets, racquetball rackets, golf clubs, baseball bats, and various other impact devices such as hammers, and the like.”

Reference numeral 13a, cited by Examiner, is not a railing, but rather the handle of tennis racket 12. (FIGS. 1-3; Col. 2, lines 61-68). The handle of a tennis racket (or golf club, hammer, etc.) does not constitute hand railing. As would be appreciated by one ordinarily skilled in the art, hand railing provides hand guidance and support along a structure. When a user grabs hand railing and applies force to it, neither the railing nor the structure to which it is attached move in a significant way, thereby providing something fixed and stable for the user to grab. The impact devices of Shomo, such as the tennis racket handle, are completely different. When a user grabs a tennis racket and applies force to it, both the handle and the racket move significantly, allowing the user to swing the racket. Therefore, it is clear that the tennis racket handle cited by Examiner does not constitute hand railing as recited in Claim 11.

Furthermore, there is no suggestion or incentive that would motivate one skilled in the art to modify Shomo so that it has a stretchable layer releasably adhered to hand railing. As mentioned above the purpose of the handle in Shomo is to accommodate impact devices that have significant freedom of movement, such as tennis rackets, golf clubs, hammers, and the like. If a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. MPEP 2143.01. Applying the device of Shomo to hand railing would prevent the device from being used on any of the impact devices in Shomo, since the stretchable layer cannot be adhered to both an impact device, requiring freedom of movement, and a railing, requiring stability, at the same time. Such a modification would render the device in Shomo unsatisfactory for its

intended purpose. Therefore, there is no suggestion or motivation to make such a modification.

Shomo also fails to disclose a skin layer axially wrapped around the outer surface of a hand railing such that the edges of the skin layer do not overlap, as recited in Claim 1. Contrary to Examiner's assertion, reference numeral 17a in Shomo is not a *skin* layer. *Merriam Webster's Collegiate Dictionary, 10th Edition* provides the following definition:

skin *n* 4 : a sheathing or casing forming the outside surface of a structure

As seen in FIGS. 1-3, outer shell 17a is not the outside surface of the structure in Shomo. Rather, a "conventional or standard tennis racket covering material, such as leather, vinyl, plastic or other suitable material, is indicated by the numeral 25, and it is illustrated as being wrapped around the outer periphery of the outer shell 17 in a conventional manner" (Col. 3, lines 43-51). Therefore, covering material 25 is the skin layer, not shell 17a. As seen in FIG. 1, covering material 25 is *spirally* wrapped, not *axially* wrapped around handle 13. It is also evident from FIG. 1 that the edges of covering material 25 *overlap*, since the outer surface of covering material 25 is not level, but rather has steps. Therefore, the skin layer in Shomo is not axially wrapped around the outer surface of a hand railing such that the edges of the skin layer do not overlap, as required by Claim 11.

Furthermore, there is no suggestion or incentive that would motivate one skilled in the art to modify Shomo so that covering material is axially wrapped around the outer surface of a hand railing such that the edges of the skin layer do not overlap.

In the Advisory Action dated September 8, 2005, Examiner states that the motivation to modify the references was found in the knowledge generally available to one of ordinary skill in the art. However, Examiner does not specify the claim limitation or the modification to which Examiner is referring. Therefore, it is unclear what claim limitation Examiner is addressing.

Even assuming that Examiner is referring to all the limitations not disclosed in Shomo, Applicant respectfully submits that it is not generally known to apply the handle of a tennis racket, or other impact device, to a hand railing. As discussed above, these are two completely different fields of use. It is also not generally known to axially wrap the skin layer of a tennis racket handle around the outer surface of a railing such that the edges of the skin layer do not overlap. As stated in MPEP 2144.03(A), it “is never appropriate to rely solely on common knowledge in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based.” It is respectfully requested that evidence be provided, if possibly citable from the prior art, to prove that the prior art teaches all of the limitations of Claim 11, including a railing having an outer surface, and a skin layer axially wrapped around the outer surface of the railing such that the edges of the skin layer do not overlap, or the rejection must be withdrawn. Broad conclusory statements standing alone are not evidence. MPEP 2144.03(C).

Applicant respectfully submits that Shomo fails to disclose all elements of Claim 11 and that there is no suggestion or incentive that would have motivated the skilled artisan to modify Shomo in order to include all the elements of Claim 11. Therefore, Applicant respectfully submits that Claim 11 is currently in condition for allowance.

Reconsideration and withdrawal of the rejection is respectfully requested.

Claims 23, 46 and 69 stand rejected under 35 U.S.C. §103(a), as being unpatentable over Shomo in view of Kobe et al. (U.S. Patent No. 6,610,382 B1).

The same arguments made above with respect to the patentability of Claim 11 are applicable to the patentability of Claims 23, 46 and 69 as well. Therefore, Applicant respectfully submits that Claims 23, 46 and 69 are currently in condition for allowance.

Reconsideration and withdrawal of the rejection is respectfully requested.

Claims 74, 76 and 78 stand rejected under 35 U.S.C. §103(a), as being unpatentable over Shomo in view of Oseroff et al. (U.S. Patent No. 3,848,480).

Since Claims 74, 76 and 78 depend from independent Claims 11, 34 and 57 respectively, they are also patentable as they contain the same limitations as their respective parent claims.

Applicant respectfully submits that Claims 74, 76 and 78 are currently in condition for allowance. Reconsideration and withdrawal of the rejection is respectfully requested.

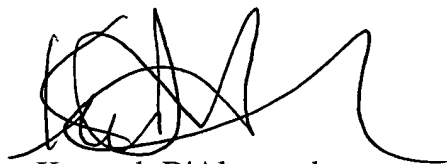
Claims 75, 77 and 79 stand rejected under 35 U.S.C. §103(a), as being unpatentable over Shomo in view of Kobe, and further in view of Oseroff.

Since Claims 75, 77 and 79 depend from independent Claims 23, 46 and 69 respectively, they are also patentable as they contain the same limitations as their respective parent claims.

Applicant respectfully submits that Claims 75, 77 and 79 are currently in condition for allowance. Reconsideration and withdrawal of the rejection is respectfully requested.

If the Examiner has any questions regarding this application, the Examiner may telephone the undersigned at 775-586-9500.

Respectfully submitted,
SIERRA PATENT GROUP, LTD.

A handwritten signature in black ink, appearing to read 'Kenneth D'Alessandro', with a long horizontal flourish extending to the right.

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